

68. (New) The assembly in claim 67, wherein said first material is present before said plasma delivery system is active.

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cont  
69. (New) The assembly in claim 68, wherein said first material is opaque to a radio-frequency wave.

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REMARKS

Claims 41-62 were pending up to this Amendment and Response.

Claims 41-62 are rejected.

Claims 63-69 are added.

Claims 41-69 are pending as a result of this Amendment and Response.

The cover sheet of the Office Action dated August 30, 2000 indicated that claims 41-62 are rejected, yet in attempting to provide the *prima facie* basis for rejection, the Examiner addressed only claims 41-59. The Examiner did not address claims 60-62. Accordingly, Applicants presume that the Examiner found them to be in allowable condition.

As for claims 41-59, the Examiner rejected them as being anticipated by United States Patent 5,916,455 by Kumagai. In doing so, the Examiner indicated that the claims contain language relating to the intended use of the devices, and that such language cannot differentiate the devices in those claims from Kumagai's apparatus. Applicants presume that the Examiner's comments are directed to the phrases in the claims that begin with "configured to . . . ." The Examiner cited as support for the rejections *In re Danly* 120 U.S.P.Q. 528 (C.C.P.A. 1959); *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 U.S.P.Q.2d 1525 (Fed. Cir. 1990); and *Ex parte Masham* 2 U.S.P.Q.2d 1647 (Bd. Pat. App. & Inter. 1987).

Applicants assert that another relevant case is *In re Venezia*, (189 U.S.P.Q. 149 (C.C.P.A. 1976) (included in an appendix for the convenience of the Examiner)) and that *Venezia* supports the notion that the "configured to" limitations at issue are actually structural limitations that meet the requirements of *Danly*, *Hewlett-Packard*, and *Masham*. The limitations for the connector assembly at issue in *Venezia* concerned (1) a pair of sleeves,

wherein each sleeve is “adapted to be fitted over” the insulating jacket of a cable addressed in the claim’s preamble, and (2) a pair of retaining members “adapted to be positioned” between the sleeves. (*Venezia*, 189 U.S.P.Q. at 150.) Focusing first on the limitations concerning the sleeves, the court found that the “adapted to” language was more than a mere direction of activities. (*Id.* at 151-52.) Rather, the court found that the language imparted a structural limitation to the sleeves. (*Id.* at 152.) Specifically, the language required each sleeve to be so structured and dimensioned that it can be fitted over the insulating jacket of a cable. (*Id.*) Similarly, the court found that the “adapted to” language limiting the retaining members provided sufficient structure. (*Id.*) The court concluded by stating the following:

We see nothing wrong in defining the structures of the components . . . in terms of the interrelationship of the components, or the attributes they must possess . . . .

(*Id.*)

The “configured to” language in claims 41-59 is analogous to the “adapted to” language in *Venezia*’s claim. Claim 41, for instance, requires a first chamber configured to generate a first plasma therein. This language requires the first chamber to be so structured and dimensioned that it can generate a first plasma therein. Claim 41 further requires a second chamber configured to initially generate a second plasma therein, further configured to lose an ability to generate the second plasma, and configured to receive the first plasma. Thus, the second chamber must be so structured and dimensioned that it can initially generate a second plasma therein, lose the ability to generate that second plasma, and receive the first plasma. Applicants further note that, by addressing the first plasma in both the first chamber and the second chamber, the “configured to” language provides further limitations concerning the structural interrelationship between the two components, as warranted by *Venezia*.

In further accordance with *Venezia*, the “configured to” language in the other relevant claims imparts structural attributes to each component as well as a structural interrelationship between the claims’ components, including claim 45’s structure and delivery system, claim 50’s first reaction device and component, claim 54’s conduit and cleaning chamber, and claim 57’s reactor and chamber. The dependent claims also benefit accordingly.

As a result, such language necessarily (1) applies to structure rather than function, as required by *Danly*; (2) covers what the device is rather than what the device does, as required by *Hewlett-Packard*; and (3) does not merely recite the manner in which a claimed apparatus is intended to be employed but rather addresses previously undisclosed structural limitations, as required by *Masham*.

Therefore, Applicants request that the Examiner either allow these claims or satisfy the *prima facie* requirements for rejection by expressly addressing these "configured to" limitations in light of Kumagai.

### Conclusion

In light of the above remarks, Applicants submit that the relevant claims are allowable over the applied reference. Therefore, Applicants respectfully request reconsideration of the Examiner's rejections and further requests allowance of all of the pending claims. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact Applicants' undersigned attorney at the number indicated.

Respectfully submitted,



Dated 2/27/11

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Appendix

*In re Venezia*, 189 U.S.P.Q. 149 (C.C.P.A. 1976)

The board cited the indication in both Pengilly and Munro that their processes led to rapid reaction time and concluded that improved reaction time would be expected if elements of those processes were combined. The evidence of record establishes, however, that reaction times of both prior processes lengthen as the processes are scaled up.

The board held the view that Munro's teaching of higher pressures to increase reaction rate would have provided an obvious solution to the problem Rinehart encountered in scaling up the process of Pengilly. But Rinehart's problem was not the need for increased reaction rate. It was, as the evidence established, the existence of lumps of frozen polymer. That problem is nowhere alluded to in either Pengilly or Munro, and of course no suggestion of a solution appears in either reference.

Moreover, Pengilly suggested that superatmospheric pressure was productive of certain disadvantages, particularly the need for use of a "large excess" of glycol. The use of superatmospheric pressure in a direct esterification process was referred to in other prior patents of record. With the exception of Munro, however, each such reference cited disadvantages of its use or an inability to find it workable. Munro's disclosure of superatmospheric pressure is rendered an abstraction with respect to appellant's problem by Munro's indication of the same excess glycol requirement when a large scale operation is contemplated. Munro employs a large excess of glycol (a ratio of glycol to acid of 3:1) in his example 5, the only example devoted to larger scale production. Rinehart's large scale production process is limited to a substantially equimolar ratio of glycol to acid. In view of all of the evidence, we cannot agree that Munro would suggest to one skilled in the art the use of superatmospheric pressure to solve the problem of scaling up the process of Pengilly.

Similarly, we find no suggestion in Pengilly or in Munro that Pengilly's preformed ester be employed in Munro's process to overcome the problems encountered in scaling up the process of Munro. Munro, as co-inventor with Lewis in earlier British Patent No. 776,282, was familiar with the use of a preformed polyester in direct esterification, yet neither Munro nor his co-inventor Maclean suggested its use with superatmospheric pressure in the cited reference. We find that the Munro patent contains its own solution to large scale operation, i.e., the use of excess glycol referred to above. That solution is not employed by appellant.

[10] Absence of any suggestion in either Pengilly or Munro that features of the

process of one should be combined with features of the other to achieve the commercial scale production of which neither is capable requires a holding that the rejection herein was improper. In re Avery, 518 F.2d 1228, 186 USPQ 161 (CCPA 1975). In view of that holding, it is unnecessary to consider Rinehart's allegations of commercial success and satisfaction of long-felt need.

The decision of the board is reversed.

## Court of Customs and Patent Appeals

In re Venezia

No. 75-601 Decided Mar. 11, 1976

### PATENTS

#### 1. Claims — Indefinite — In general (§20.551)

##### Construction of specification and claims — Defining terms (§22.45)

Claims that define claimed invention's metes and bounds with reasonable degree of precision and particularity are 35 U.S.C. 112, second paragraph, definite; claim language calling for sleeves "adapted to be fitted" over insulating jacket imparts structural limitation to sleeve rather than merely directing activities to take place in future; structures of components of completed assembly may be defined in terms of interrelationship of components, or attributes they must possess, in completed assembly.

#### 2. Claims — Indefinite — Mechanical (§20.556)

Claims reciting all essential parts of "kit" of parts that may or may not be made into completed assembly are not incomplete for failing to recite completed assembly.

#### 3. Claims — Indefinite — In general (§20.551)

In re Collier, 159 USPQ 266, is inapposite to claims containing language precisely defining present structural attributes of interrelated component parts of "kit" so that later assembly may be effected, rather than describing activities that may or may not occur.

#### 4. Double patenting — In general (§33.1)

##### Patentability — Subject matter for patent monopoly — In general (§51.601)

Court of Customs and Patent Appeals decisions on double patenting are not

applicable to interpreting 35 U.S.C. 101 "any manufacture;" Section 101 "same invention" type double patenting cases construe "a patent therefore."

**5. Patentability — Subject matter for patent monopoly — In general (§51.601)**

Group or "kit" of interrelated parts is 35 U.S.C. 101 "manufacture," and is not excluded from patent protection.

**Particular patents — Splicing**

Venezia, Method of Splicing High Voltage Shielded Cables and Splice Connector Therefor, rejection of claims 31-36 reversed.

**Appeal from Patent and Trademark Office Board of Appeals.**

Application for patent of J. William Venezia, Serial No. 31,500, filed Apr. 24, 1970. From decision rejecting claims 31-36, applicant appeals. Reversed.

Donald R. Dunner, and Lane, Aitken, Dunner & Ziems, both of Washington, D.C. (S. Michael Bender, North Tarrytown, N.Y., Richard A. Craig, New York, N.Y., and Arthur Jacob, Hackensack, N.J., of counsel) for appellant.

Joseph F. Nakamura (T.E. Lynch, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Lane, Judge.

This is an appeal from the decision of the Patent and Trademark Office Board of Appeals (board) affirming the rejections of claims 31 through 36 in application serial No. 31,500, filed April 24, 1970, for "Method of Splicing High Voltage Shielded Cables and Splice Connector Therefor." We reverse.

**The Invention**

Appellant's invention is a splice connector having interrelated parts adapted to be assembled in the field to provide a splice connection between a pair of high voltage shielded electric cables.

Appellant's application contains claims drawn to the completed connector and to the method of making the splice connection, which have been allowed by the Patent and Trademark Office. On appeal before us are claims drawn to a splice connector "kit" consisting of the parts which are used in

making the splice in their unassembled condition.

Claim 31, with our emphasis, is representative of the claims on appeal:

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cables and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber

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**The Rejection**

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Claims under 35 to a plurality listed and manufacture

**The Board**

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enclosing at least said contact means and the exposed portions of said cable conductors when said housing is in its repositioned location.

#### The Rejections

Claims 31-36 were rejected under 35 USC 112, second paragraph, as indefinite and incomplete in not defining a completed article of manufacture. The examiner particularly relied on *In re Collier*, 55 CCPA 1280, 397 F.2d 1003, 158 USPQ 266 (1968), as support for this rejection.

Claims 31-36 were additionally rejected under 35 USC 101 because they were drawn to a plurality of separately and discretely listed and defined manufactures instead of a manufacture.

#### The Board

The board at first unanimously sustained both of the above rejections. With respect to the section 112 rejection it stated:

In the *Collier* case, the two elements [see bracketed elements [1] and [2] of *Collier* claim 17, *infra*] recited specifically in the claims there under consideration were described in terms of intended uses and capability, and the like. The Court said:

"We agree with the Board, however, that the claim does not positively recite structural relationships of the two elements, identified as (1) and (2) above, in its recitation of what may or may not occur. In this sense it fails to comply with section 112, [second paragraph] In [sic] failing distinctly to claim what appellant in his brief insists is his actual invention."

An inspection of the claims here under consideration, see for example claim 31 above, discloses a similar situation. Although the preamble refers to the structure as a "kit", the elements are recited without present cooperation. The language is futuristic and conditional in character, thus, a pair of sleeves - to be fitted - electrical contact means - to be affixed - a pair of retaining numbers [sic, members] - to be positioned - a housing - may be slideably positioned - slideably repositioned - when said sleeves are assembled on said cables - when said housing is in its repositioned location.

From the above it is clear that the language of the claim taken as an example is directed to assembly to take place in the future. No present positive structural relationships are recited.

In affirming the section 101 rejection the board stated:

[Appellant] urges that the elements of his claimed combination are "joined together in a kit of component parts". Such joining as may be recited in the claims, as we have pointed out above in connection with the rejection under 35 USC 112, relates to matters which may take place in the future. No *present* coercion is recited. The presence of the word "kit" in the preamble, we do not think fairly links the elements separately recited in the claims. Appellant has referred to no language in the claims which would support such "joining" and we know of none. [Emphasis in original.]

In a subsequent decision, upon reconsideration, one of the board members dissented, finding that appellant had distinctly claimed what he regarded as his invention under section 112. The dissenting member of the board also found that it was not fatal under section 101 that the cooperation of the claimed elements was recited as occurring at a future time.

This posture of the board remained intact following a third opinion rendered after a second request for reconsideration by appellant.

#### Opinion

##### Section 112 Rejection

[1] We have reviewed the disputed claims and in particular the language criticized by the examiner and the board. We conclude that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity, and that they are, therefore, definite as required by the second paragraph of section 112. *In re Conley*, 490 F.2d 972, 180 USPQ 454 (CCPA 1974); *In re Miller*, 58 CCPA 1182, 441 F.2d 689, 169 USPQ 597 (1971); *In re Borkowski*, 57 CCPA 946, 422 F.2d 904, 164 USPQ 642 (1970). As we view these claims, they precisely define a group or "kit" of interrelated parts. These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves \* \* \* each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables." Rather than being a mere direction





The solicitor in his brief recognizes that the Patent and Trademark Office has in the past issued patents containing similar claims drawn to "kits" of interrelated parts.<sup>1</sup> He argues, however, that double patenting decisions by this court, holding that an inventor may obtain only one patent on a single invention, show that this court has interpreted portions of section 101 in the singular. From this he reasons that the word "manufacture" in section 101 is to be similarly interpreted.

[4] We do not find our decisions on double patenting to be applicable to an interpretation of the words "any manufacture" in section 101. Suffice it to say that the two situations are totally dissimilar. In the section 101 "same invention" type double patenting cases, all we were construing was the phrase "a patent therefor."

No other authority has been cited, either by the board or the solicitor, to support the narrow construction which the Patent and Trademark Office now seeks to impose on the words "any manufacture" in section 101.

[5] We do not believe the words in question are to be so narrowly construed. To hold that the words "any manufacture" exclude from their meaning groups or "kits" of interrelated parts would have the practical effect of not only excluding from patent protection those "kit" inventions which are capable of being claimed as a final assembly (e.g., a splice connector), but also many inventions such as building blocks, construction sets, games, etc., which are incapable of being claimed as a final assembly. We do not believe Congress intended to exclude any invention from patent protection merely because it is a group or "kit" of interrelated parts. We therefore hold that a group or "kit" of interrelated parts is a "manufacture" as that term is used in section 101.

Accordingly, the decision of the board is reversed.

<sup>1</sup> There are copies of several patents in the record which contain "kit" claims exemplifying this prior practice, including patent No. 3,108,803, claiming a basketball goal set kit, patent No. 3,041,778, claiming a puppet kit, patent No. 1,974,838, claiming a toy construction set, and patent No. 3,355,837, also claiming a toy construction set.

## Patent and Trademark Office Trademark Trial and Appeal Board

In re The Cyclone Seeder Co., Inc.

Decided Oct. 20, 1975

Released Dec. 19, 1975

### TRADEMARKS

#### 1. Identity and similarity — How determined — Dominant feature (§67.4065)

##### Identity and similarity — Words — Similar (§67.4117)

"Speedy" is determining element in "Cyclone Speedy Spreader," "Spreader" being disclaimed, with "Cyclone" modifying "Speedy" and suggesting enormous speed; "Cyclone Speedy Spreader" for broadcast spreader/seeders so resembles "Speedy" for corn cribs, power operated agricultural insecticide sprayers, corn shredders, and row crop shields that confusion is likely.

Appeal from Examiner of Trademarks.

Application for registration of trademark of The Cyclone Seeder Co., Inc., Serial No. 439,884. From decision refusing registration, applicant appeals. Affirmed.

Oltch & Knoblock, South Bend, Ind., for applicant.

Before Lefkowitz and Bogorad, Members, and Rice, Acting Member.

Bogorad, Member.

An application has been filed by The Cyclone Seeder Co., Inc. to register the mark "CYCLONE SPEEDY SPREADER", the word "SPREADER" being disclaimed, for broadcast spreader/seeders.

Registration has been refused under Section 2(d) of the Act of 1946 on the ground that applicant's mark as applied to the goods specified in its application so resembles the previously registered mark "SPEEDY" for corn cribs, power operated agricultural insecticide sprayers, corn shredders and row crop shields for use on cultivators<sup>1</sup> as to be likely to cause confusion or mistake or to deceive.

<sup>1</sup> Reg. No. 680,737 issued June 23, 1959, affidavit under Sec. 8 accepted, affidavit under Sec. 15 received.